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EXAMINER

NAJJAR, SALEH

ART UNIT	PAPER NUMBER
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2157

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/442,791
Filing Date: November 18, 1999
Appellant(s): IMS ET AL.

Catherine K. Kinslow (registration No. 51,886)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 30, 2004.

REAL PARTY IN INTEREST

A statement identifying the real party in interest is contained in the brief.

(RELATED APPEALS AND INTERFERENCES)

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

STATUS OF THE CLAIMS

The statement of the status of the claims contained in the brief is correct.

STATUS OF AMENDMENT

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

SUMMARY OF INVENTION

The summary of invention contained in the brief is correct.

ISSUES

The appellant's statement of the issues in the brief is correct.

GROUPING OF THE CLAIMS

The appellants' statement of the grouping of the claims in the brief is correct.

CLAIMS APPEALED

The copy of the appealed claims contained in the appendix of the claims (pages 10-15 of the Appeal Brief) is correct.

PRIOR ART OF RECORD

U. S. Patent No. 6,167,441, published on December 26, 2000, filed on November 21, 1997 by Himmel, and U. S. Patent No. 6,237,040, published on May 22, 2001, filed on July 7, 1998 by Tada.

NEW PRIOR ART

No new prior art has been applied in this examiner's answer.

GROUND OF REJECTION

Claims 1, 3-8, 10-12, 14-19, 21-23, 25-30, 32-34, and 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Himmel, U.S. Patent No. 6,167,441 further in view of Tada, U.S. Patent No. 6,237,040.

Himmel teaches the invention substantially as claimed including providing customized Internet content to a client based on requester type (see abstract).

As to claim 1, Himmel teaches a method in a data processing system, comprising the steps of:

receiving, from a client, a request for a host screen (see col. 4, lines 45-55; col. 5, lines 15-20, Himmel discloses that URL request which identifies somehost is received from a client); navigating to the host screen; retrieving the host screen (see fig. 2; col. 4, lines 49-51, Himmel discloses that an HTML page containing response data that is in a format optimized for the particular client is sent to the client);

formatting the host screen into a formatted host screen, wherein the formatted host screen displays selectable links to other screens within a host system; and sending the formatted host screen to the client (see col. 7, lines 49-52, Himmel discloses that an HTML page containing embedded URL's in a format optimized for the particular client is returned to the client).

Himmel fails to teach the limitation of formatting the host screen from a non-markup language. Himmel does teach that FTP (file transfer protocol) and GOPHER sites exist for access on the Internet (see col. 1, lines 30-31). Himmel also discloses that the invention supports any browser, even back level browsers that may not support a particular language or version of the language, which became prevalent since the browser was written (see col. 7, lines 55-60). Himmel further discloses that Internet protocols other than HTML can be used and adapted to the teachings of the invention (see col. 9, lines 54-58).

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However, Tada teaches a system and method to enable the automatic processing of non-HTML data such as e-mail data even if the user terminal has a browser that only supports HTML (see abstract; col. 1, lines 45-50). Tada teaches **formatting the host screen from a non-markup language to a markup language** (see col. 3, lines 10-12; col. 4, lines 45-50; col. 5, lines 27-41; col. 6, lines 1-15, Tada discloses that when he user submits an e-mail service request, non-HTML data (email data) is converted to an HTML file which is represented by an embedded markup tag on a web page for the user selection and displayed by the browser).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Himmel in view of Tada so that non-HTML files such as email are accessed by a HTML browser. One would be motivated to do so since retrieving email represents a typical task in the Internet browsing experience.

As to claim 3, Himmel teaches the method as recited in claim 1, wherein the step of navigating to the host screen comprises retrieving at least one intermediate screen in order to retrieve the host screen (see col. 6, lines 7-9, Himmel discloses that the client receives an intermediate web page having selections for identifying the type of client device).

As to claim 4, Himmel teaches the method as recited in claim 1, further comprising:

responsive to a determination that variable data is needed to navigate to the host screen, sending to the client a submittable form containing text fields that may be filled in by a user; and responsive to receiving the variable data from the client, using the variable data to retrieve the host screen (see col. 6, lines 7-15, Himmel discloses that a fillable web page is presented for identifying the type of client device).

As to claims 5-6, Himmel teaches the method as recited in claim 1, wherein the client is a portable data processing system and wherein the portable data processing system is a wireless system (see col. 3, lines 10-11; col. 4, lines 1-5).

As to claim 7, Himmel teaches the method as recited in claim 3, wherein the intermediate screen is not presented to the user (see col. 5, lines 45-67, Himmel

teaches that a snooper may discover the client capabilities by analyzing the request header without the user interaction).

As to claim 8, Himmel teaches the method as recited in claim 3, wherein appropriate entries are made in the at least one intermediate screen in order to navigate to the host screen (see col. 6, lines 7-9, Himmel discloses that the client receives an intermediate web page having selections for identifying the type of client device).

As to claims 10-11, Himmel teaches the method as recited in claim 1, wherein the formatting step formats the host screen into a markup language wherein, the markup language is an extensible markup language (XML), and wherein the markup language is a hypertext markup language (HTML) (see col. 1; lines 60-65).

Claims 12, 14-21 represent a program, which is parallel to method claims 1, 3-11, and therefore are rejected for similar reasons. Himmel discloses that the method and system can be implemented in software or firmware (see col. 9, lines 65-67).

Claims 23, 25-33 represent apparatus that are parallel to method claims 1, 3-11 and therefore are rejected for similar reasons. Himmel discloses that the method and system can be implemented in software or firmware or hardware or in combination (see col. 9, lines 65-67; col. 10, lines 1-5).

As to claim 34, Himmel teaches a script for providing navigation between screens within a legacy host system, the script comprising:

first instructions for receiving a request for a requested host screen from a legacy host system (see col. 4, lines 45-55; col. 5, lines 15-20, Himmel discloses that URL request which identifies somehost is received from a client)

second instructions for determining the current host screen; and third instructions for navigating to the requested host screen (see fig. 2; col. 4, lines 49-51, Himmel discloses that an HTML page containing response data that is in a format optimized for the particular client is sent to the client);

wherein intermediate host screens between the current host screen and the requested host screen are unsent to a client (see col. 5, lines 45-67, Himmel teaches that a snooper may discover the client capabilities by analyzing the request header without the user interaction);

fourth instructions for formatting the host screen into a formatted host screen, wherein the formatted host screen displays selectable links to other screens within host system; and sending the formatted host screen to the client (see col. 7, lines 49-52, Himmel discloses that an HTML page containing embedded URL's in a format optimized for the particular client is returned to the client).

Himmel fails to teach the limitation of formatting the host screen from a non-markup language. Himmel does teach that FTP (file transfer protocol) and GOPHER sites exist for access on the Internet (see col. 1, lines 30-31). Himmel also discloses that the invention supports any browser, even back level browsers that may not support a particular language or version of the language, which became prevalent since the browser was written (see col. 7, lines 55-60). Himmel further discloses that Internet protocols other than HTML can be used and adapted to the teachings of the invention (see col. 9, lines 54-58).

However, Tada teaches a system and method to enable the automatic processing of non-HTML data such as e-mail data even if the user terminal has a browser that only supports HTML (see abstract; col. 1, lines 45-50). Tada teaches **formatting the host screen from a non-markup language to a markup language** (see col. 3, lines 10-12; col. 4, lines 45-50; col. 5, lines 27-41; col. 6, lines 1-15; Tada discloses that when he user submits an e-mail service request, non-HTML data (email data) is converted to an HTML file which is represented by an embedded markup tag on a web page for the user selection and displayed by the browser).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Himmel in view of Tada so that non-HTML files such as email are accessed by a HTML browser. One would be motivated to do so since retrieving email represents a typical task in the Internet browsing experience.

Himmel fails to teach the claimed limitation of a "macro bean". Himmel does teach that a java script or java program can be used to implement the snooping functionality of the server for identifying the client and the requested page (see col. 5, line 67; col. 6, line 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Himmel by specifying the Java script / program as a macro bean since the same functionality of implementing a script to identify the client device and the requested web page is achieved. One would be motivated to do so since a script when executed, plays out the commands of a macro emulating the environment of the requesting client and runs the commands as if it was interacting directly with a user.

As to claim 36, Himmel teaches the script as recited in claim 34, further comprising fifth instructions for entering appropriate data at intermediate host screens in order to access the requested host screen (see col. 6, lines 7-15, Himmel discloses that a fillable web page is presented for identifying the type of client device).

Himmel fails to teach the claimed limitation of a "macro bean". Himmel does teach that a java script or java program can be used to implement the snooping functionality of the server for identifying the client and the requested page (see col. 5, line 67; col. 6, line 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Himmel by specifying the Java script / program as a macro bean since the same functionality of implementing a script to identify the client device and the requested web page is achieved. One would be motivated to do so since a script when executed, plays out the commands of a macro emulating the environment of the requesting client and runs the commands as if it was interacting directly with a user.

As to claim 37, Himmel teaches the macro bean as recited in claim 34, wherein variable data received from a client is entered appropriately into one or more of the intermediate host screens (see col. 6, lines 7-15, Himmel discloses that a fillable web page is presented for identifying the type of client device).

Himmel fails to teach the claimed limitation of a "macro bean". Himmel does teach that a java script or java program can be used to implement the snooping functionality of the server for identifying the client and the requested page (see col. 5, line 67; col. 6, line 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Himmel by specifying the Java script / program as a macro bean

since the same functionality of implementing a script to identify the client device and the requested web page is achieved. One would be motivated to do so since a script when executed, plays out the commands of a macro emulating the environment of the requesting client and runs the commands as if it was interacting directly with a user.

Response to Arguments

The examiner summarizes the various points raised by the appellant and addresses replies individually.

As per appellants' arguments filed on July 30, 2004, the appellants argued in substance that the examiner is using an improper hindsight analysis in rejecting the claims (see page 4 of the Brief).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA, 1971). In this case the Himmel reference fails to teach the limitation of formatting the host screen from a non-markup language. Himmel recognizes that FTP (file transfer protocol) and GOPHER sites exist for access on the Internet (see col. 1, lines 30-31). Himmel also discloses that the invention supports any browser, even back level browsers that may not support a particular language or version of the language, which became prevalent since the browser was written (see col. 7, lines 55-60). Himmel further discloses that Internet protocols other than HTML can be used and adapted to the teachings of the invention (see col. 9, lines 54-58). The secondary reference Tada teaches a system and method to enable the automatic processing of non-HTML data such as e-mail data even if the user terminal has a browser that only supports HTML (see abstract; col. 1, lines 45-50).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Himmel in view of Tada so that non-HTML files such as email are accessed by a HTML browser since Himmel recognizes the existence of non-HTML data and since retrieving email represents a typical task in the Internet browsing experience.

The applicant further argues that there is no teaching or suggestion to combine the references since Himmel provides the user with an immediate response with a customized version of the requested web page data and since Tada provides deferred access to non-HTML data (see page 7 of the brief).

In response, providing an immediate response or providing deferred access is not issues of concern in the Himmel and Tada references nor is such language found in the present invention's claims. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). For the above reasons,

In this case, Himmel recognizes the existence of non-HTML data such as FTP (file transfer protocol) and GOPHER sites (see col. 1, lines 30-31). Himmel also discloses that the invention allows any browser, even back level browsers which may not support a particular language or version of the language which became prevalent since the browser was written to access Internet content (see col. 7, lines 55-60). Himmel further discloses that Internet protocols other than HTML can be used and adapted to the teachings of the invention (see col. 9, lines 54-58). Tada teaches a system and method to enable the automatic processing of e-mail data (non-HTML data) which represents Internet content even if the user terminal has a browser that is outdated and only supports HTML (see abstract; col. 1, lines 45-50). One of ordinary

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skill in the art would certainly find it obvious to modify Himmel in view of Tada so that e-mail (non-HTML data) is accessed by a HTML browser since retrieving email represents a typical task in the Internet browsing experience.

The applicant further argues that the Himmel and Tada references do not teach the limitation of a macro bean to perform the functionalities of the claims (see pages 8-9 of the brief).

In response, Himmel fails to teach the claimed limitation of a "macro bean". Himmel does teach that a java script or java program can be used to implement the snooping functionality of the server for identifying the client and the requested page (see col. 5, line 67; col. 6, line 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Himmel by specifying the Java script / program as a macro bean since the same functionality of implementing a script to identify the client device and the requested web page is achieved. One would be motivated to do so since a script when executed, plays out the commands of a macro emulating the environment of the requesting client and runs the commands as if it was interacting directly with a user.

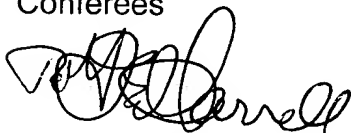
For the above reasons, it is believed that the rejections should be sustained.

October 29, 2004



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Conferees



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